No. 192. 36

Reply Brf. of Miller for Petitioner

Office Supreme Court U.S.
FILED
MAR 18 1902
JAMES H. McKENNEY,
Clerk.

No. 192.

IN THE

Supreme Court of the United States.

Filed Mar. 18, 1902.

OCTOBER TERM, 1901.

CLINTON E. WORDEN & CO.,
Appellant,

vs.

CALIFORNIA FIG SYRUP CO.,
Appellee.

REPLY BRIEF OF APPELLEE.

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For Appellant.

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In the Supreme Court of the United States.

CLINTON E. WORDEN & Co., Appellant, vs. CALIFORNIA FIG SYRUP CO., Appellee.	No. 192. October Term, 1901.

APPELLANT'S REPLY BRIEF.

I.

Appellee's Change of Position.

In our opening brief we undertook to show that the term "Syrup of Figs" could not constitute a valid trade-mark. The appellee had contended in the lower court, as we construed the argument, that those words did constitute a valid trade-mark. Such had always been the theory of appellee.

In the first case brought, *California Fig Syrup Co. vs. Improved Fig Syrup Co.* (51 Fed. R., 296), the opening sentence of the opinion is: "This is a case of infringement of a trade-mark."

And further on in the same decision it is said: "The basis of the suit is the effort of the respondent to imitate the trade-mark of the complainant."

When that case reached the Court of Appeals the same view was taken by both counsel and Court. Indeed, the syllabus of the decision (54 Fed. R., 175)

says, *inter alia:* "The phrase 'Syrup of Figs' * * * constitutes a valid trade-mark."

It is conceded that in the two cases in the First and Sixth Circuits the appellee claimed the words as a trade-mark.

In the case at bar we understand that the same claim was made in the lower court. The bill alleges that the medicine has always been "marked, named and called by your orator Syrup of Figs" (Rec., 17); that the appellee has exclusive right to the name Syrup of Figs, etc. (*Id.*, 21), and the prayer is for an injunction against selling a laxative "marked with the words Syrup of Figs," etc. (*Id.*, 27).

The Circuit Court held in the case that it involved both a question of trade-mark and unfair competition. The appellee's position is stated by the Court as follows:

"But, on the part of the complainant, it is claimed that this is not merely a trade-mark case, but that it goes further and involves unfair competition * * * in this circuit, the Circuit Court of Appeals, in the case of *Improved Fig Syrup Co. v. California Fig Syrup Co.*, 54 Fed., 175, has, in my judgment, determined that this complainant is entitled to be protected, not only in its trade-mark, but in its business," etc., etc. (Rec., 576).

The decree entered enjoins the sale of the medicine "under the name Syrup of Figs," broadly and without regard to labels or character of packages (*Id.*, 582).

In the Court of Appeals the case was treated on the same theory. No one reading the opinion (Rec., 637-644) can fail to note this palpable fact.

It is true that the decision was based on the ground of unfair competition by reason of simulated labels and wrappers, but still the right to a trade-mark was asserted by appellee and challenged by appellant. By reason of the foregoing, we stated in our opening brief that this case was of a two-fold nature—viz., trade-mark proper and unfair competition by use of simulated labels and wrappers.

In the brief filed in this Court by appellee, the position taken in the lower Courts concerning the question of trade-mark has been abandoned, and a distinctly new theory put forward. Of course, we do not question the right of counsel to do this. It is not infrequently the case, in litigation, that eminent counsel is made to see the error of his former argument, and in such event it is the part of wisdom, as well as indicative of a broad mind, to abandon the old, and try some new theory.

In the opening sentence of appellee's brief it is said, in reference to the name in dispute :

> " The name is descriptive of the article originally put on the market, and, therefore, under many of the authorities, could not be treated as a trade-mark."

We construe this as an abandonment of the contention that the name is a trade-mark, and felicitate ourselves on the fact that our learned brother has been converted to our faith, although it be at the eleventh hour.

The position now taken by appellee is in substance as follows :

> That the name Syrup of Figs, though not a valid trade-mark proper, is a valid trade name, and, at such, will be protected on the score of unfair competition in trade.

Or, to put it in another form, a name which cannot be appropriated as a trade-mark, because descriptive, may be appropriated as a trade name, and its use *simpliciter* may be enjoined, as in the case of a technical trade-mark, without regard to the character of labels or wrappers on which it is printed. In other words, a trader, by merely calling his invalid trade-mark a trade name, is entitled to all the protection he would get if the name were a valid trade-mark.

There is no such principle of law, so far as we are aware, and certainly the learned counsel for appellee has not shown any authority therefor. But whether this name be a trade-mark or a trade-name, the rule of law is inexorable that it will not be protected if its use is tainted with fraud. A change in principle does not follow from a mere change in name. There is no magic in a name, and the appellee cannot overturn a principle of law by legerdemain of language. We care not whether the name be called trade-mark or trade-name, the rule of law is the same in either event. If the appellee has been guilty of fraud or misrepresentation in its use of the name, it has no standiag in a court of equity. Its hands are unclean, and he who hath committed inequity shall not have equity.

Permit us to examine the facts a little more in detail. It is asserted by our adversary that the name, when originally adopted in 1879, was descriptive, because it contained a large quantity of figs, and, consequently, it was a true and honest name *when originally adopted* (Brief, 2, 18).

If this be true, then the appellee's offense is worse than we ever charged it to be. It is admitted by Mr. Queen that in his earliest experiments he used large quantities of figs, but that he discovered this to be deleterious to the medicine, causing it to ferment and spoil; consequently, he discontinued using large quantities of figs and reduced them to the present infinitesimal amount, so that the name is no longer descriptive. The learned counsel for appellee would have us believe that this reduction in the amount of figs was not made until after the medicine had acquired its reputation (Brief, 9). This fact would be immaterial, if it were a fact, but it is not a fact. On the contrary, Mr. Queen testifies that during the year 1878 he made experiments, which subsequently resulted in the production of his medicine; that he first "used figs freely;" that as he progressed with his experiments he found that a large quantity of figs was deleterious,

causing the medicine to ferment, and, therefore, he reduced it to a small quantity; that, as finally prepared, the medicine had "a very small" quantity of fig juice in it, which gave no more effect than "an equal quantity of honey or some other substance" would have given (Record, 52).

He further said in his testimony: "I knew that I was not using the name generically, because figs did not give effect and character to the combination" (Record, 52).

The medicine was first put on the market at Reno early in the year 1879 (Record, 81–82).

It will thus be seen that after the experiments with large quantities of figs in 1878 and the discovery that they were deleterious, the fig juice was reduced to its present infinitesimal amount, which was of "no more value than an equal quantity of honey," and then the name "Syrup of Figs" was adopted; after which, in 1879, the medicine was first put on the market.

The above testimony of Mr. Queen contradicts point-blank and without equivocation the following statement found on page 9 of appellee's brief concerning the reduction of the quantity of fig juice in the medicine, viz.:

"But this reduction was after the name had been given in good faith, and after the demand for it required the manufacture in large quantities."

It will thus be seen that the name was not "a true and honest name when applied to the medicine" (Appellee's Brief, 2). It never was an honest name.

In our opening brief we argued that Mr. Queen, in adopting it, intended to convey to the public the impression that it was descriptive, although, as matter of fact, it was not descriptive. We here reiterate our belief in that regard. We think it too palpable for argument that such was Mr. Queen's intention. He wanted the public to think it was a medicine made from figs, in order to avail himself of the popular impression that figs are laxative, notwith-

standing the fact that his experiments had demonstrated to absolute certainty that figs in substantial quantities, sufficient to make the name descriptive, would be deleterious, and that the actual quantity of fig juice used was so infinitesimal that it " was of no more value than an equal quantity of honey." These facts would seem to dispose of Mr. Queen's pretended honest intention in adopting the name.

In this connection counsel for appellee assert (Brief 2) that we admit that the name was originally descriptive, and they cite pages 10, 11 and 12 of our opening brief. The statement is inaccurate. Our admission was that Mr. Queen *intended* the name to be descriptive when he originally selected it and used large quantities of figs. The distinction is apparent at a glance, and we marvel greatly that it was not noted by such learned counsel as those who represent the appellee.

But grant, for argument's sake, that the name was descriptive when originally adopted in 1879, as contended by counsel, nevertheless it is, beyond all doubt, that shortly after its adoption it ceased to be descriptive by reason of the withdrawal of the figs from the compound, and never has been descriptive since. In other words, however, honest it may have been at its birth, this " child of his invention," so styled by counsel (Brief, 8), grew up as, and lived the life of, a reprobate. It would, indeed, be a novel doctrine of ethics to claim palliation for the sins of one's adult years by pointing to the innocence of his birth. Whatever may have been Mr. Queen's intention in 1878 when he was experimenting, surely there can be no doubt as to his intention, as manifested by his conduct, during the twenty-four years following while selling the medicine.

The facts, in a nut-shell, seem to be about as follows : In 1878–9 Mr. Queen, desiring to take advantage of and trade upon the popular idea that figs are laxative, prepared a medicine in which he proposed to use large

quantities of fig-juice, and gave it the name syrup of figs, in order that the public might think it was made of figs and thereby be induced to buy it on account of the supposed laxative properties of figs; that he soon discovered, by actual experimentation, that fig-juice in substantial quantity was deleterious to the medicine and caused it to ferment; that, thereupon, he withdrew the fig-juice from the compound in substantial quantity and used only an infinitesimal quantity thereof, which added nothing to the medical properties of the compound, and was of no more value than so much honey; that he retained this infinitesimal quantity of fig-juice merely to be able to say that figs entered into the compound; that during the twenty-four years following its selection he has used this name for the purpose of inducing the public to believe that the medicine contained figs in substantial quantity, and therefore possessed the supposed laxative property of figs.

Our contention on this branch of the case is:

1. *If the words Syrup of Figs were claimed as a trade-mark, it could not be protected by reason of fraud, because the medicine is not a syrup made from figs.*

2. *Calling the name a trade-name, instead of a trade-mark, is nothing more than a distinction without a difference, because the rule of law against fraud applies to trade names (or for that matter to labels, packages or anything else) with the same force and in the same way as to trade-marks.*

3. *Even if this name were honest in the beginning, when originally adopted, it soon ceased to be so, and is now a fraudulent one, is in and of itself a falsehood, to such extent that equity will not protect it.*

II.

As to the Percentage of Fig Juice in the Appellee's Medicine.

The learned counsel for appellee claims that "there is no justification in the record for counsel's [our] contention that the amount of fig juice is less than one-tenth of one per cent." (Brief, 10).

In that behalf it is claimed that the amount is "a little less than one per cent." (Brief, 9).

There is no denial of the fact that Mr. Queen testified in the case against Stearns that the percentage of fig juice was as we have stated. He then testified that in one thousand gallons of the medicine there was about one gallon of fig juice (Record, 95-6). This is one-tenth of one per cent.

And in that case the Court found as a fact that there was less than one-tenth of one per cent. of fig juice present.

Syrup Co. vs. Stearns, 73 Fed. R., 813.

It is not claimed that this quantity of fig juice has been increased since then. On the contrary, we have Mr. Queen's statement that the quantity of fig juice used now is the same as it was then—viz., the soluble part of one hundred pounds of figs to a thousand gallons of the medicine (Record, 94).

He states, however, that he has since discovered that the soluble part of the fig is greater than he then calculated, and that he thinks now, in the light of his new experience, that the percentage of fig juice is "a little less than one per cent." On page 97 of the record he says that in one thousand gallons of his medicine he calculates that there would be about from seven to nine gallons of fig juice. This would be *about from seven to nine-tenths of one per cent.*

In other words, he testified in the Stearns' case that the percentage was one-tenth of one per cent., and the Court found as a fact that it was less than one-tenth of one per cent.; while in the case at bar he testified that it was "a little less than one per cent.," admitting at the same time that the amount, whatever it be, is the same now that it was then.

In this connection it is interesting to note that another witness, Louis T. Queen, a brother of Richard E., testified that there is about seven and a half or eight per cent. of fig juice in the medicine (Rec., 264); but it is evident that his testimony is not true, and is in hopeless conflict with that of his brother, who "invented" the medicine. Even the appellee's counsel takes no stock in it. It may be useful, however, in weighing the value of the witness' testimony on other points.

It is apparent that the testimony of both brothers is pure guess work. But whatever may be the percentage of fig juice, whether one-tenth of one per cent. or a little less than one per cent., the indisputable fact is that the actual amount now used is precisely the same as it was in the Stearns case, and that said amount is so minute that it adds nothing to the medicine either one way or the other.

Mr. Richard Queen says that the fig is not an essential part of the compound (Rec., 101); that the flavor of figs cannot be detected in the medicine *(Id., 99)*; that the fig juice is of no more value than an equal quantity of honey or some other substance *(Id., 52)*; that the medicine would be just as good without any fig juice at all *(Id., 98)*.

Indeed, Mr. Queen went so far as to testify that "on one or two occasions" he made the medicine without using any figs at all *(Id., 133)*.

According to Judge TAFT, there is "just a suspicion of fig juice" present.

According to Judge GILBERT, the amount is so small as to have no effect "either in promoting the pleasant taste or otherwise."

We assert, therefore, whether the percentage is one-tenth of one per cent., as claimed by us, or a little less than one per cent., as claimed by appellee, the result is the same. The use of it is a fraud and subterfuge, put there, according to Judge TAFT, "simply to give a week support to the statement that the article sold is syrup of figs. This is a fraud on the public."

III.

Original and Present Labels.

The learned counsel for appellee take us to task for asserting that the original label used by appellee was the same as that which was in use at the time of the adverse decisions in the First and Sixth Circuit (Brief, 16, 17).

We have always labored under that impression and we still believe that it is a fact; but the matter is immaterial, and we are willing, for the purposes of this case, to accept the counsel's statement, which we understand to be as follows: That the label in controversy in the Stearns and Putnam cases was adopted in may, 1889, and was used until some time in 1896—seven years—and that the label used prior to May, 1889, had no direct statement on it referring to figs, but did have the name "Syrup of Figs" and the picture of a young lady holding up a fig branch.

These facts do not change the phase of the controversy in the least. They merely show that the appellee has been deceiving the public for not quite so long a period as we asserted.

IV.

Appellee's medicine as viewed by physicians and druggists.

Quite a portion of appellee's brief is devoted to showing that physicians and druggists think highly of the medicine, and recommend it as a good remedy for constipation. On the trial appellee went so far as to call several medical men to prove the fact.

We do not consider this material. The value of the medicine as a remedy could cut no figure in the case, unless it were harmful, which we do not assert. Hence, all that portion of the brief may be dismissed from further consideration.

V.

Conduct of Clinton E. Worden & Co.

A very large part of the appellee's brief is devoted to a verbal chastisement of Clinton E. Worden & Co. for selling fig syrup, and they are charged with "stealing" the business of appellee and all kinds of fraud upon the public.

We beg to remind the learned counsel that this is not the place or occasion for the exhibition of temper or indulgence in vituperation. It is a proposition of law which this Court is asked to decide, and it can scarcely be supposed that such language will aid the Court in reaching a correct solution of that proposition of law.

And, furthermore, we venture to remind the learned counsel that the solution of the legal question involved is not dependent on, nor in any way affected by, the conduct or motives of Clinton E. Worden

& Co., but is dependent solely and entirely on the conduct of the California Fig Syrup Company. We contend that this last-named company is not entitled to protection in the name Syrup of Figs, because its conduct in connection with that name is, and for many years past has been, fraudulent. It is no answer to that proposition for the appellee to abuse its rival. They must first clear themselves of the charge of fraud before this Court will listen to their complaint. The conduct of the appellee, not that of the appellant, is the gist of the case, the fundamental point at issue. We have the highest authority for asserting that before a person should undertake to pluck a mote from his brother's eye, he should cast the beam out of his own.

VII.

Decisions Cited in Appellee's Brief.

The number of decisions cited is appalling, but they are all in the same category, and the answer to one is an answer to all. The one most relied on is *Reddaway vs. Benham* (L. R., 1896, App. Cas., 199).

In that case the plaintiff manufactured a belting from camel's hair and other ingredients. This article was stamped with the picture of a camel and the name "camel's hair" belting. There was no element of fraud on the part of the plaintiff. On the contrary, the article was made of camel's hair and the name was an honest one. It was held that the plaintiff was entitled to protection; but even the protection which was awarded was of a limited character, for the injunction was merely that the defendant should not use the words "without clearly distinguishing such belting from the belting of the plaintiff" (see form of injunction at end of the decision).

In other words, the defendant could use the words "camel's hair," but he must be careful to use them in such way as not cause the public to confuse his belting with that of the plaintiff. Suppose, however, the plaintiff's belting had not been made of camel's hair, but of horse hair, can any one doubt what would have have been the decision? Would not the Court have refused relief on the ground that plaintiff was selling horse hair belting for camel's hair belting?

Indeed this case seems to us to furnish the most cogent reason for reversing the decree in the case at bar. Reddaway stamped the picture of a camel and the words "camel's hair" on his belting, thereby asserting that the belting was made of camel's hair, and this assertion was true. The belting was made of genuine camel's hair. In the case at bar appellee stamps on its labels the picture of a fig branch and the words "Syrup of figs," thereby asserting that the medicine is a syrup made from figs. This assertion is false. Is not this a fraud, and, if so, is the appellee entitled to any relief under the doctrine laid down by the House of Lords in *Reddaway vs. Benham?* If it be a fraud to sell horse hair belting under the name comel's hair belting, we must confess our inability to understand how it can be right to sell syrup of senna under the name syrup of figs.

Take now the case of *Singer Mfg. Co. vs. June Mfg. Co.*, 163 U. S., 169. This Court there laid down the same rule of law, holding that the defendant could not be enjoined absolutely from using the name "Singer," because that was the name of an article which everyone had a right to make, but that one could be enjoined from using the name in such way as to induce the public to think that his machines were actually made by the Singer Company.

A similar ruling was made in the companion case of *Singer vs. Bent*, 163 U. S., 205.

The ruling in these two cases was followed by the House of Lords in *Reddaway vs. Benham*, cited *supra*.

We must remark of these cases, as we did of the Reddaway case, there was no fraud in the plaintiff's conduct. Its machines were the genuine Singer machines of world-wide reputation. If they had not been Singer machines, but a spurious article with no part of the Singer invention in them, is it possible to conceive that this Court would have protected the company in such fraudulent use of the name?

Apply the law of this decision to the case at bar. The medicine in question is not patented or protected by any exclusive right. Its name is syrup of figs. Every one has a right to make it and sell it. Having such right to make and sell, he has a right to call it by its name. Indeed, to call it by another name would be a misrepresentation. Therefore, no injunction will lie at the hands of the appellee against the use generally and absolutely of the name as applied to the medicine. The only relief the appellee could, under any circumstance, be entitled to, would be the same kind of relief granted by this Court to the Singer Company, and it would not be entitled to that, if guilty of fraud, which we contend it is.

In *Brown Chemical Co. vs. Meyer*, 139 U. S., 542, it was held that the words "Brown's Iron Bitters" could not be protected as a trade-mark because they were descriptive, but that their use by a person of the same name could be enjoined if he had used them in such way as to deceive the public, and induce purchasers to take his goods as and for those of the plaintiff. No fraud was shown in the use of the words by the plaintiff. If such fraud had been shown—for instance, if his bitters had no iron in them, or only an infinitesimal amount—then he could have gotten no relief of any kind, however fraudulent were the acts of the defendant.

The case of *Prince vs. Prince Metallic Paint Co.*, 135 N. Y., 25, is strongly in point, and *Schmidt vs. Brieg*, 100 Cal., 672, is equally so. In the last case it was held that the defendant could not be enjoined absolutely from using the name "Sarsaparilla and Iron,"

because that name, being descriptive, was not a valid trade-mark ; but that he could be enjoined from using it in such way as to enable him to pass off his goods as and for those of the plaintiff. There was no charge of fraud against the plaintiff.

The rule of law deducible from the cases cited in appellee's brief is apparent. There is nothing new about it, for this Court has applied it frequently. We state it as follows :

No injunction will be granted against the use of a name *simpliciter*, which is not a valid trade-mark ; but an injunction may be granted against its use in such way as to deceive the public and enable the defendant to pass off his goods for those of the plaintiff, provided always, however, that the plaintiff is guilty of no materially false representation in his own use of the name, in which event he is entitled to no relief whatever, however fraudulent may be the conduct of defendant.

We ask for nothing more than an application of this rule to the case at bar. Our position is :

1. The words syrup of figs are not a valid trade-mark, and, consequently, an injunction against their use *simpliciter* cannot be granted.
2. In no event could the appellee be entitled to any further relief than an injunction against the use of said words when made in such a way as to deceive the public and enable the defendant to pass off his goods as and for those of the complainant, but even such limited relief could not be granted if complainant is himself guilty of fraud in the use of the name.
3. The complainant is guilty of fraud in its use of the name, and, therefore, is entitled to no relief of any kind.

All of which is respectfully submitted.

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